

**This Opinion is a
Precedent of the TTAB**

Mailed: October 29, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vox Populi Registry Ltd.

Serial No. 86700941
Serial No. 87187215

Robert M. O’Connell, Jr. and John P. McCormick of Fish & Richardson, P.C.
for Vox Populi Registry Ltd.

Kim Teresa Moninghoff, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

Before Kuhlke, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant, Vox Populi Registry Ltd., has filed an application (“Application ’941”) seeking registration on the Principal Register of the standard character mark .SUCKS for the following services:¹

Domain registry operator services related to the gTLD in the mark, in International Class 42; and

¹ Application Serial No. 86700941 was filed on July 22, 2015. For the Class 42 services, Applicant claims first use of the mark anywhere and in commerce on March 30, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). For the Class 45 services, Applicant claims a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Domain name registration services featuring the gTLD in the mark; registration of domain names for identification of users on a global computer network featuring the gTLD in the mark, in International Class 45.

Applicant also filed an application (“Application ’215”) to register the mark:

.SUCKS

in connection with Class 42 “domain registry operator services related to the gTLD in the mark.”²

As discussed in more depth in this decision, “gTLD” is an abbreviation for a generic Top Level Domain (“TLD”). gTLDs serve as components of Internet addresses.

The Trademark Examining Attorney has refused registration of Applicant’s proposed marks pursuant to Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051-1053, 1127, on the ground that, when used in connection with the identified services, each fails to function as a mark.

Applicant has appealed the refusals and the appeals have been briefed. In view of the similarity of the marks and in-part identity of services, as well as the shared basis for refusal, we consolidate the appeals and issue a single decision. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1214 (June 2020).

I. Application ’941 – Preliminary Evidentiary Objection

Applicant has raised an evidentiary objection with respect to Application ’941.

² Application Serial No. 87187215 was filed on September 29, 2016. Applicant claimed first use of the mark anywhere and in commerce on March 21, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

By way of background, Applicant concurrently appealed and filed a request for reconsideration.³ The then-assigned Examining Attorney⁴ denied the request for reconsideration, the appeal resumed, and Applicant filed an appeal brief.⁵ In lieu of filing an appeal brief, the Examining Attorney requested remand of the application “so that the examining attorney may inquire as to the nature of the contract between applicant and ICANN and the applicant’s ownership of the applied-for mark” and “because of the existence of new evidence that is relevant [to the failure to function refusal].”⁶ The Examining Attorney attached to the remand request materials regarding the Internet Corporation for Assigned Names and Numbers (ICANN), the organization that helps govern the use of TLDs. The Board granted the remand “in view of the circumstances set forth therein.”⁷

On remand, the Examining Attorney issued an Office Action and attached additional evidence not included with the remand request to support the failure to

³ 1 TTABVUE (appeal) and 4-5 TTABVUE (request for reconsideration).

Citations to TTABVUE throughout the decision are to the Board’s public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the Trademark Office’s online Trademark Status and Document Retrieval system (TSDR).

⁴ Examining Attorney Seth Rappaport was originally assigned responsibility for examination of the application. The Office re-assigned the application to Examining Attorney Kim Moninghoff on November 7, 2017. We hereinafter use “Examining Attorney” to refer to either person.

⁵ 6-7 TTABVUE (denial of request for reconsideration) and 9 TTABVUE (Applicant’s brief).

⁶ 11-20 TTABVUE (request for remand).

⁷ 21 TTABVUE (Board order granting remand).

function refusal.⁸ Applicant responded to this Office Action and argued that “the new evidence [attached to the Office Action] is untimely and improper.”⁹ Ultimately, no additional refusal was asserted and proceedings resumed based solely on the failure to function refusal.¹⁰ Applicant filed a supplemental brief and the Examining Attorney then filed a brief.

In its supplemental brief, Applicant argues that “no valid grounds for remand existed, and the post-remand Office Action was thus untimely and improper.”¹¹ Applicant specifically objects to copies of online articles that the Examining Attorney attached to the post-remand Office Action.¹² Applicant requests that “all arguments and evidence raised by the Examining Attorneys in the post-remand Office Action and the post-remand Final Refusal should be deemed waived and not given any consideration by the Board.”¹³

To the extent that Applicant seeks to challenge the Board’s remand order in its appeal brief, we disagree with Applicant’s assertion that “no valid grounds” existed for remand. At the very least, good cause for remand existed based on the Examining Attorney’s request for additional information as to the nature of Applicant’s contract

⁸ TSDR May 4, 2017 Office Action.

⁹ TSDR November 2, 2017 Response.

¹⁰ 23 TTABVUE.

¹¹ 24 TTABVUE 7.

¹² Applicant refers to the post-remand Office Action issued on May 4, 2017, and articles at TSDR pp. 30-62. In its supplemental brief, Applicant points out that the Examining Attorney submitted an “updated screen image of Applicant’s website,” but states that this is “substantively identical to the screen image already in the record.” 24 TTABVUE 9, Note 1.

¹³ 24 TTABVUE 10.

with ICANN. Indeed, in the post-remand Office Action, the Examining Attorney made several such information requests, to which Applicant responded. Accordingly, the Board's remand order stands and the materials attached to the motion for remand have been considered,¹⁴ as well as the subsequent information requests contained in the post-remand Office Action and Applicant's responses thereto.

With respect to Applicant's objection to the material attached to the post-remand Office Action and the arguments made in connection therewith, it is moot because our findings and holding do not rely on any of this material or argument made in connection therewith.¹⁵

II. Application '941 -- Failure to Function

There is no dispute that .SUCKS is a generic top level domain (gTLD).¹⁶ A gTLD is identified by the string of letters following the last "dot" in a website or email address or document on the Internet. In 2011, ICANN authorized a program to introduce numerous new gTLDs.¹⁷ Under this program, ICANN's Registry Agreements include specifications that differentiate between gTLD strings composed of existing trademarks, "brand" gTLDs (Specification 13), and those that are "generic string" gTLDs (Specification 11). *See In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, 2020 BL 350997 at *4, n.18. Specification 11 defines a "generic

¹⁴ We note that although the ICANN materials were not attached to the post-remand Office Action, Applicant has not objected to these materials.

¹⁵ To be clear, we have not considered the evidence attached to the May 4, 2017 Office Action.

¹⁶ TSDR November 2, 2017 Response ("Applicant does not dispute that '.sucks' is a gTLD.").

¹⁷ TSDR September 9, 2015 Office Action, p. 11.

string” gTLD as “a string consisting of a word or term that denominates or describes a general class of goods, services, groups, organizations or things, as opposed to distinguishing a specific brand of goods, services, groups, organizations or things from those of others.”¹⁸ By way of a 2014 Registry Agreement between ICANN and Applicant’s predecessor-in-interest, and a subsequent assignment, Applicant is the designated “Registry Operator” for the generic string gTLD “.Sucks,” subject to the terms and conditions of the Registry Agreement.¹⁹ Applicant’s Registry Agreement with ICANN includes Specification 11, applicable to generic string gTLDs, but does not include Specification 13.²⁰

“Registry operator” services involve “maintain[ing] the master database of all domain names registered in each top-level domain, and also generat[ing] the ‘zone file,’ which allows computers to route Internet traffic to and from top-level domains anywhere in the world.”²¹ “Registrar” services, on the other hand, involve the registration of domain names for others, and a gTLD registrar is “responsible for keeping website contact information records and submitting the technical information to a central directory (i.e., the ‘registry’).”²²

¹⁸ 12 TTABVUE 5; 4 TTABVUE 179 (Exhibit G to Applicant’s request for reconsideration).

¹⁹ Exhibit G to Applicant’s request for reconsideration. 4 TTABVUE 89-181.

²⁰ *Id.*; see also TSDR November 2, 2017 Response in which Applicant confirmed that its registry agreement does not include Specification 13.

²¹ TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1215.02(d) (October 2018).

²² *Id.* The TMEP further distinguishes entities like “registry operators” and “registrars” (or domain name registration services), from domain name “re-sellers,” which are entities that are authorized by registrars to sell or register particular Internet addresses on a given top-level domain. See TMEP § 1215.02(d), citing to the ICANN website’s “Glossary” (<http://www.icann.org/en/about/learning/glossary>).

The USPTO set forth its policy guidance with regard to the handling of applications for marks composed entirely of gTLDs for domain name registry operator and domain name registration (or “registrar”) services in Section 1215.02(d) of the TMEP:

A mark composed solely of a gTLD for domain-name registry operator or registrar services fails to function as a trademark because consumers are predisposed to view gTLDs as merely a portion of a web address rather than as an indicator of the source of domain-name registry operator and registrar services. Therefore, registration of such marks must initially be refused ... on the ground that the gTLD would not be perceived as a mark.

Although the USPTO is not bound by ICANN’s criteria for its program to introduce new gTLDs, in view of ICANN including in its program new gTLDs based on existing brand names, the USPTO’s guidance acknowledges that, “in some circumstances, a gTLD may have source-indicating significance.” *Id.* The guidance provides in relevant part that:

[T]he applicant may, in some circumstances, avoid or overcome the refusal by providing evidence that the mark will be perceived as a source identifier. In addition, the applicant must show that: (1) it has entered into a currently valid Registry Agreement with the Internet Corporation for Assigned Names and Numbers (“ICANN”) designating the applicant as the Registry Operator for the gTLD identified by the mark and (2) the identified services will be primarily for the benefit of others.

In both appeals, the Examining Attorney concedes that a current, valid agreement exists showing that ICANN has designated Applicant as the Registry Operator for

the gTLD .SUCKS, and that Applicant's recited services will be for the benefit of others.²³ We therefore do not address these issues in this decision.

However, the Examining Attorney maintains that Applicant is not the owner of a prior U.S. registration on the Principal Register for the gTLD shown in the mark for goods/services that are related to the identified subject matter of the websites to be registered, which TMEP § 1215.02(d)(i) requires an applicant to submit as evidence to show that the gTLD will be perceived as a source identifier. We observe that a prior registration is relevant evidence, but not dispositive either way of the ultimate question before us on appeal, which is whether consumers will perceive .SUCKS as capable of functioning as a source identifier for domain name registry operator and domain name registration services. *See AC Webconnecting*, 2020 USPQ2d 11048, at *3. As discussed below, we find the record ultimately demonstrates that consumers perceive .SUCKS as a gTLD and not as a source identifier for Applicant's services described in the application – namely, domain name registry operator services and domain name registration services that feature or relate to the aforementioned gTLD.²⁴

²³ Application '941 - 26 TTABVUE 14 (Examining Attorney, in the Supplemental brief, "agrees that the applicant has met the [first and second] requirements of this section [of the TMEP]"); and Application '215 – 6 TTABVUE 10, same language.

²⁴ Although we do not rely on the issue of whether Applicant owns a prior registration, we note that Applicant concedes that it does not own a prior registration for a .SUCKS mark related to the subject matter of the websites registered with that gTLD. 24 TTABVUE 13 ("Applicant does not itself own a prior registration for '.SUCKS' or 'SUCKS'"). Furthermore, Applicant's objection to the Examining Attorney's requirement to establish ownership of a prior registration as untimely (24 TTABVUE 12) is moot in view of Applicant's concession that it does not own such a registration. In other words, regardless of the timing of the requirement being asserted, Applicant would not be able to satisfy the requirement.

“The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify.” *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), quoted in *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017). To function as a service mark, a proposed mark must, by definition, “identify and distinguish the services of one person ... from the services of others and ... indicate the source of the services, even if that source is unknown.” 15 U.S.C. § 1127. “For any proposed mark, including a gTLD, the determination whether the designation is capable of functioning as a mark focuses on consumer perception.” *AC Webconnecting*, 2020 USPQ2d 11048, at *3 and cases cited therein; *see also In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *1-2 (TTAB 2019) (“The key question is whether the asserted mark would be perceived as a source indicator for Applicant’s [goods or] services.”); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“[T]he critical inquiry is whether the asserted mark would be perceived as a source indicator.”).

Here, the involved application identifies the services as relating to or featuring the gTLD .SUCKS. In other words, as described in the application, Applicant’s services involve offering to register domain names ending with the gTLD .SUCKS, and Applicant will be acting as the registry operator, maintaining the database, for all domain names that end with the gTLD .SUCKS.

With regard to how consumers perceive proposed marks consisting solely of a gTLD, we observe that the mere registration of a term as a gTLD does not establish

that the matter functions as a trademark, just like the mere registration of a term as a domain name does not establish any trademark rights. See *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ 1545, 1555 (9th Cir. 1999). As the Board recently explained in *AC Webconnecting*, consumers are “highly conditioned” to view a gTLD as signifying its function as a portion of an Internet domain name, and due to this consumer predisposition and the fact that “gTLDs are intended to be used by multiple, often numerous, parties as part of their own domain names,” a gTLD proposed for registration as a mark for services involving registration of domain names in the specified gTLD typically will not be perceived as a source indicator. 2020 USPQ2d 11048, at *3; see also *Image Online Design, Inc. v. CORE Ass’n*, 120 F. Supp. 2d 870, 880 (C.D. Cal. 2000) (“Plaintiff’s use of the mark .web in connection with domain name preregistration services does not confer trademark protection. As a gTLD, .web does not indicate the source of the services; instead, it indicates the type of services. The Court finds that .web, as used here, falls out of the ambit of trademark categorization. Further, even if it could be categorized, .web is simply a generic term for websites related to the World Wide Web. Accordingly, the mark is not protectable.”); 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:17.50 (5th ed. 2019) (a TLD like .com “has no source indicating significance and cannot serve any trademark purpose”).

The Examining Attorney argues that “because a gTLD serves an inherent purpose as part of the address at which websites are located, it does not create in the minds of users an immediate recognizable ‘device’ to indicate the source of the domain

registry operator and domain registration services.”²⁵ The Examining Attorney further points out that consumers of Applicant’s services are those “seeking to register domain names containing the gTLD .SUCKS and registrars providing registration of domain names containing the gTLD .SUCKS, which ensures [consumers] would perceive .SUCKS as a gTLD.”²⁶ Referring to the specimen of use and other printouts from Applicant’s website, the Examining Attorney acknowledges that .SUCKS is displayed prominently “in the upper left corner where trademarks and service marks commonly appear,” but asserts that this is not sufficient to overcome the term’s primary significance as a gTLD and “the content on the page discussing .SUCKS clearly indicates to consumers that they can register domain names with this gTLD to voice their displeasure or disapproval with a certain entity, individual, movement, etc.”²⁷

Applicant, on the other hand, argues that it uses .SUCKS as a source-identifier and that the evidence shows that it is perceived as such by its customers. Applicant also contends that it heavily promotes .SUCKS. In support, Applicant submitted the declaration of its Director and Chief Operating Officer, Aimee Deziel, who avers that Applicant “has spent substantial sums in the advertising and promotion of its services under the .SUCKS brand (irrespective of design format).”²⁸ Deziel

²⁵ 26 TTABVUE 8.

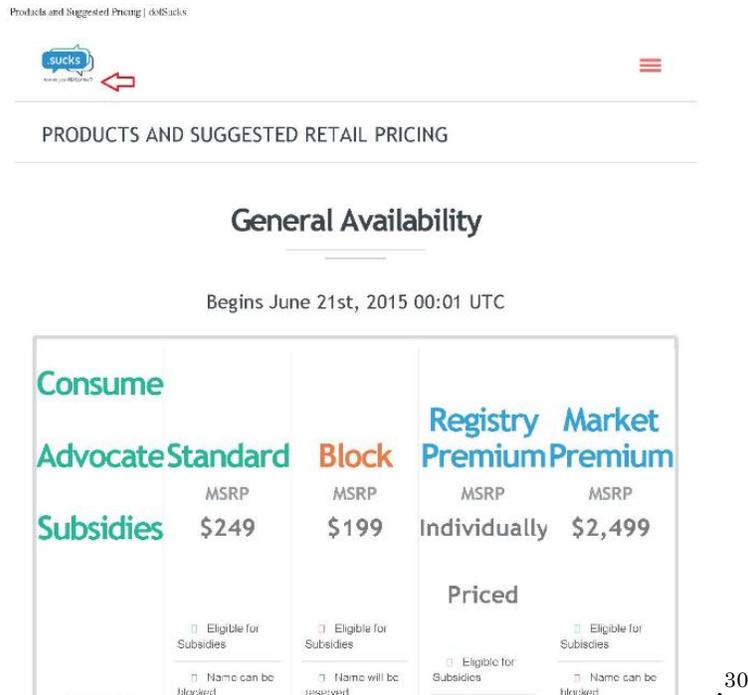
²⁶ *Id.*

²⁷ *Id.* at 9.

²⁸ TSDR November 2, 2017 Response to Office Action, p. 3.

specifically states that Applicant “spent approximately \$200,000 on the promotion of its mark in the United States in 2015, and will have spent 1,500,000 ... in 2016.”²⁹

Applicant’s specimen of use in the application depicts the applied-for mark in the following manner:

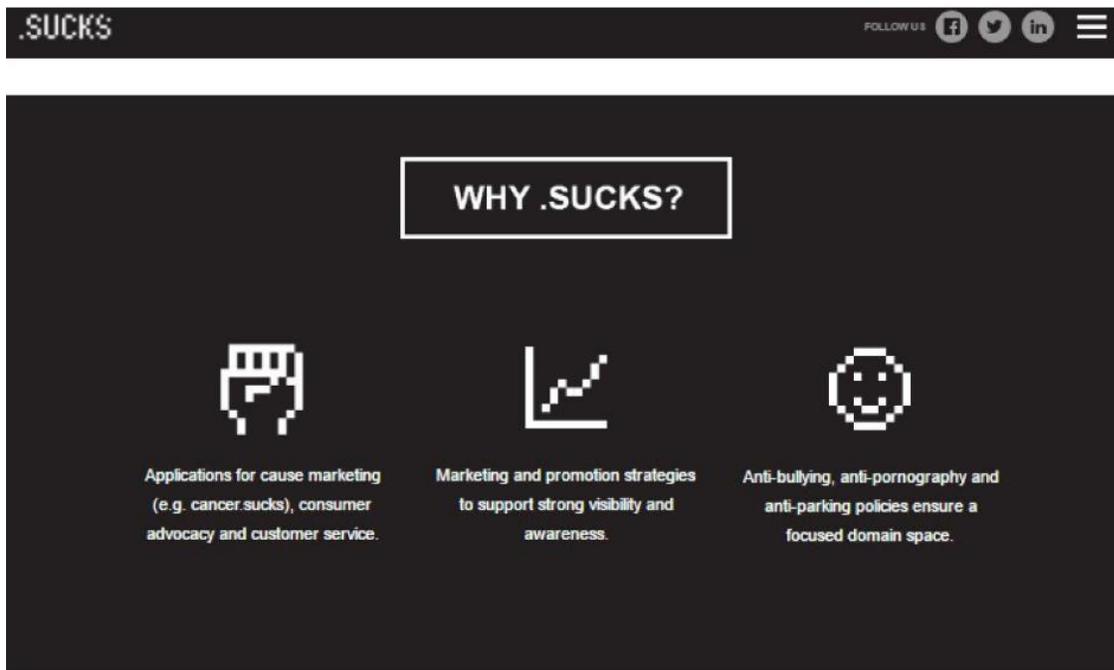


Additional printouts from Applicant’s website show .SUCKS in the following manners:³¹

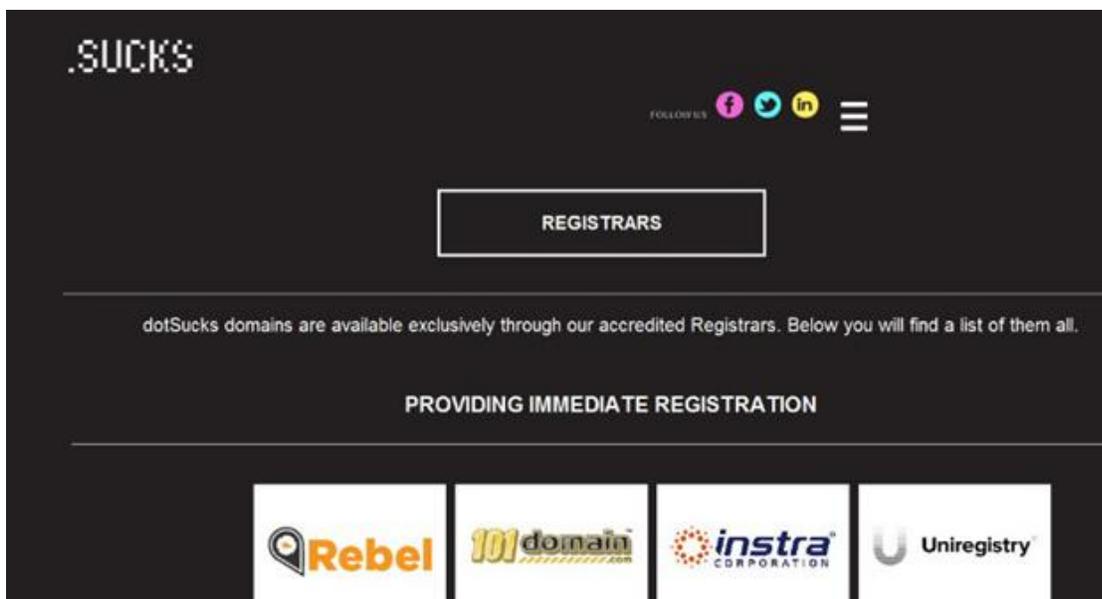
²⁹ *Id.* Applicant also provided a declaration of Ms. Deziel during the prosecution of Application ’215 (at TSDR April 21, 2017 Response to Office Action, pp. 13-14). Ms. Deziel essentially provided the same information but with slightly more detail, stating that Applicant spent \$1,500,000 in 2016, “which is roughly broken down into \$1,000,000 spent before May 21, 2016, and \$500,000 after May 21, 2016, which is the date on which the [applied-for mark in Application ’215] was first used” and that Applicant “will have spent approximately \$300,000” in 2017, to promote Applicant’s services “under the .SUCKS mark [stylized] mark.”

³⁰ TSDR Specimen p. 1 (filed on July 22, 2015).

³¹ 4 TTABVUE (Applicant’s Request for Reconsideration).



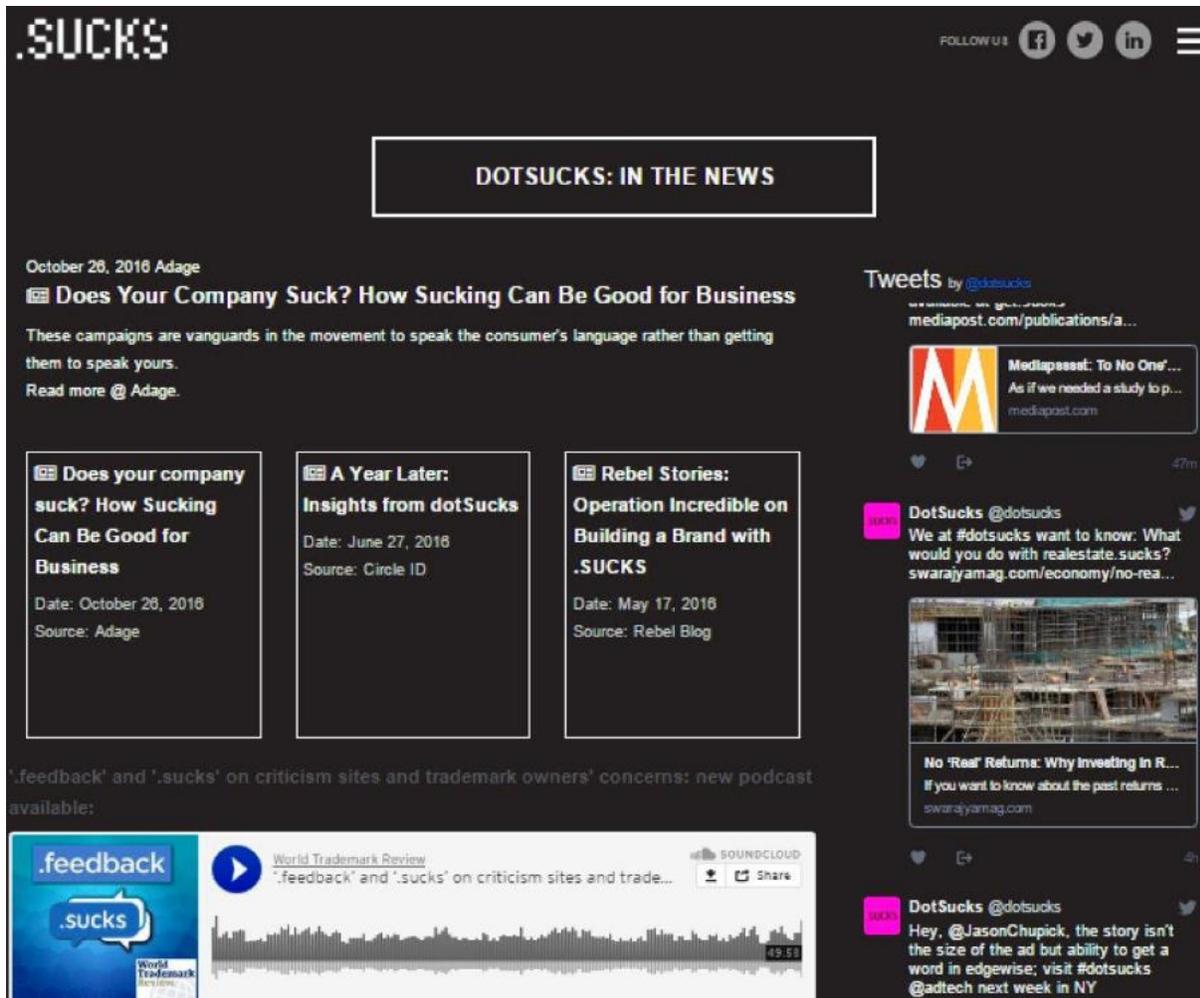
;32



;33 and

³² *Id.* at 25.

³³ *Id.* at 27.



The specimens make clear that Applicant’s domain registry operator and registrar services relate specifically to Internet addresses that will have the gTLD .SUCKS; to wit, Applicant identifies what it refers to as, “premium names ... hav[ing] exceptional value in the context of the dotSucks domain. For example, life.sucks and divorce.sucks.”³⁵ Consumers viewing Applicant’s website will therefore be aware that .SUCKS is a gTLD and that domain names will be registered and maintained via Applicant’s domain registry operator and registrar services. In short, as the Registry

³⁴ *Id.* at 29.

³⁵ *Id.* at p. 2.

Operator services, .SUCKS is more akin to Applicant's product, not its brand. When a table maker sells tables, the word "table" is simply the common descriptive name of the table maker's product; it cannot be the table maker's brand.

In view of the informal or slang meaning of the term "sucks,"³⁶ Applicant suggests various ways this gTLD can be used by others. As the above excerpts from Applicant's website show, Applicant proposes that others may and will use the gTLD for purposes such as "cause marketing (e.g., cancer sucks)." However, such manner of use of the gTLD by various other entities, as contemplated by Applicant, reduces any possibility that consumers will view Applicant's use of the gTLD as a source-identifier. That is, third-party use of the gTLD reduces any distinctiveness of the term and detracts from it pointing uniquely to Applicant as a single source for domain registry operator and registrar services.³⁷ In other words, because consumers will possibly be directed to other sources that could include third-party trademarks in conjunction with the domain name, this may undermine the ability of the gTLD to serve as a single source identifier.

³⁶ We take judicial notice that the term is defined in the Merriam-Webster dictionary as "*slang, sometimes vulgar*: to be objectionable or inadequate." MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (11th ed.) and www.merriam-webster.com, last accessed on April 1, 2019). *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions; *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006) (judicial notice of online dictionaries that exist in printed format or regular fixed editions).

³⁷ In this regard, Specification 11 in the Registry Agreement prohibits a Registry Operator of a generic string TLD from imposing eligibility criteria for registering names in the TLD that limit registrations exclusively to a single person or entity. 4 TTABVUE 179.

Applicant further relies on three “consumer declarations” submitted with its request for reconsideration.³⁸ Applicant asserts that the declarants represent registrars (accredited companies that sell domain names to the public) and thus are recipients of Applicant’s domain registry operator services. Applicant notes that two of these registrars represent half of all the others currently providing registration of the .SUCKS gTLD. Applicant argues these declarations “are significant of how ordinary consumers of Applicant’s services perceive [the applied-for mark, .SUCKS].”³⁹

Each declaration consists of six short points and in substance is nearly identical to the others. Each declaration has the same conclusory sentence – “When I see the .SUCKS service mark, I immediately recognize it as identifying the domain name registry services offered by Vox Populi [Applicant].” The declarations are probative; however, we keep in mind that these registrars are in the business of promoting and selling domain names with the gTLD .SUCKS to the public. Thus, while the declarants may be recipients of Applicant’s domain registry operator services, they also share a pecuniary interest with Applicant, namely the success of the gTLD. They have entered into an agreement with Applicant that focuses on the marketing of the gTLD and the nature of their own services involves using .SUCKS as merely a gTLD. While these declarants may be more knowledgeable than the average consumer seeking to register a domain name and be aware that Applicant is the sole registry

³⁸ 4 TTABVUE 36-39.

³⁹ 24 TTABVUE 15.

operator for .SUCKS gTLD, this does not mean that they will use .SUCKS as a source-identifying mark for Applicant's domain registry operator services. Rather, when these registrars are offering to register potential domain names, .SUCKS will be used to describe the gTLD, not Applicant, in the domain names to be registered.

The statements made by the declarants are also at odds with evidence submitted by the Examining Attorney showing how others use .SUCKS in connection with the gTLD. In support of the denial of Applicant's request for reconsideration, the Examining Attorney attached website printouts from three different entities offering to register .SUCKS domain names.⁴⁰ For example, United Domains offers to register .SUCKS domains in the following manner:

⁴⁰ 6-7 TTABVUE; see also evidence attached to TSDR Office Action April 29, 2016.



.SUCKS Domain Info

Registration Price	starting at \$249
Registration Period	1 Year
Multi-Year-Registration	up to 10 Years

;41

with the following information being provided on the same website:

Premium Names Available

Premium domain names are available for the .SUCKS domain extension. These Domain Names carry an increased cost of registration, and may be higher than the standard registration price. They are considered more valuable than other domains because they are based on common words or phrases people often use in their online searches. The premium classification is determined by the domains' registry.

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Another example, the Instra Corporation, is one of Applicant's accredited registrars and offers domain registration services in the following manner:

⁴¹ 7 TTABVUE 7.

⁴² *Id.* at p. 9.



This evidence of third-party use by entities involved in selling .SUCKS domain names shows .SUCKS used only as the gTLD. The applied-for mark is advertised as merely one possible gTLD in connection with available second level domains.

The Examining Attorney also submitted articles discussing the gTLD .SUCKS and mentioning Applicant.⁴⁴ These articles refer to the gTLD only to describe possible new domain names and not as a source identifier for domain name registration or registrar services. For example, a 2015 article from the website www.arstechnica.com

⁴³ *Id.* at 14.

⁴⁴ 6-7 TTABVUE.

titled “Pricing raises accusations of ‘extortion’ and ‘shake downs,’” describes the advent of the new (at the time) gTLD in the following manner:⁴⁵

The number of generic top-level domains (gTLDs) available for use has climbed into the hundreds, and “.sucks” will soon be added to the list. However, angry customers eager to get their hands on brand-specific domains like “bestbuy.sucks” or “comcast.sucks” shouldn’t get their hopes up ...

The pricing situation around .sucks domain names is complicated. Companies with registered trademarks will have to pay an astounding \$2,499 to register their trademarked names in .sucks. Registration of non-trademarked names during [dates] before .sucks goes live will cost ...

Companies are typically hypersensitive about brand usage, and few will want their .sucks domains under someone else’s control. The .sucks pricing scheme has led to outrage...

Another 2015 article appearing on the Slate website (www.slate.com), “If you want a ‘Sucks’ Domain Name, It Could Cost You \$2,500,” describes the gTLD in the following manner:⁴⁶

Vox Populi [Applicant], the company that will be selling the .sucks website names, will charge \$2,500 for certain registered trademarks with a .sucks name.

There’s some controversy amid the buildup to the release of .sucks domains. ...

(Just as an example of what companies should be worried about with “.sucks,” check out ... [website]).

A third online article, from the PC World website (www.pcworld.com), is titled “The .SUCKS domain is coming soon to an angry website near you,” and notes ICANN’s approval of the “.SUCKS domain as part of the new gTLD expansions.”⁴⁷

⁴⁵ 7 TTABVUE 20.

⁴⁶ 6 TTABVUE 10-11.

⁴⁷ *Id.* at 12-17.

The article acknowledges Applicant as “the company behind the .SUCKS TLD” and the entity “that owns the right to administer the .SUCKS domain,” however, it is also clear from the article that the gTLD is only just that, a gTLD. Or, due to the slang meaning of the term “sucks,” the gTLD represents an opportunity “for common people to make their voices heard” or “a shakedown by selling acerbic domains to companies at a high price lest they fall into more hateful hands.”⁴⁸

Weighing all of the evidence of record and arguments, we find that .SUCKS, as used by Applicant and applied for in standard characters, will not be perceived as a source identifier for Applicant’s Class 42 domain registry operator services or its Class 45 domain name registration services. Rather, the entirety of the evidence leads us to conclude that .SUCKS, when viewed in the context of domain registry and registrar services, will be perceived merely as one of many gTLDs that are used in domain names. We acknowledge Applicant’s attempts to use .SUCKS in a manner that source-identifying marks are used; however, the evidence shows that consumers will view it as only a non-source identifying part of a domain name, rather than as a mark.

III. Application ’215 – Failure to Function

A. Analysis of the **.SUCKS mark**

In evaluating the failure to function refusal with respect to Applicant’s applied-for **.SUCKS** mark, we maintain that the .SUCKS element will be perceived as

⁴⁸ *Id.*

merely a gTLD when it is viewed in connection with Applicant's recited "domain registry operator services related to the gTLD [.SUCKS] in the proposed mark." For the reasons given, *supra*, and based on the record before us, we do not find the literal element of this mark, .SUCKS, would be perceived as source-identifying and distinguishing the applied-for services.

As to the stylization of the literal element .SUCKS, described in the application as a "font suggesting an LED display," it has been established that "for a term otherwise unregistrable to be capable of distinguishing an applicant's goods, the presentation of the term must be sufficiently striking, unique or distinctive so as to overcome its inherent incapacity and render the mark capable of serving as a source indicator." *In re Cosmetic Factory, Inc.*, 220 USPQ 1103 (TTAB 1983). The decision of capability is dependent on the nature of the presentation of the unregistrable matter in each case.

Where an element of a mark is held unregistrable, as is the case here with .SUCKS, a design or stylization may render the overall mark registrable if it creates an impression on purchasers separate and apart from the impression made by the unregistrable term itself. *Cf. In re Cordua Rests.*, 823 F.3d 594, 118 USPQ2d 1632, 1638-1639 (Fed. Cir. 2016) (affirming Board's refusal of registration of stylized mark CHURRASCOS on the Supplemental Register based on finding that the stylization "does not create a separate commercial impression over and above that made by the generic term."). Accordingly, we must determine if the stylization of Applicant's mark

creates a separate commercial impression ‘over and above’ that made by the term .SUCKS.

B. Whether the Proposed Mark’s Stylization Creates a Separate Commercial Impression

Applicant asserts that its stylization “unmistakably sets the subject mark apart from marks composed solely of a gTLD.”⁴⁹ In addition to the description of the mark in the application, Applicant refers to the stylization as “a ‘retro’ pixelated font that resembles how letters were displayed on early CRT computer screens.”⁵⁰ Applicant cites to prior Board decisions in which a stylization or design was sufficiently distinctive to create a separate commercial impression and thus make the mark registrable, such as *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986) (holding **CONSTRUCT-A-CLOSET** registrable despite component wording found merely descriptive of goods used to construct personal storage systems), and *In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976) (stylized mark  held “sufficiently distinctive” and registrable with a disclaimer of the geographically descriptive wording “Jackson Hole”).

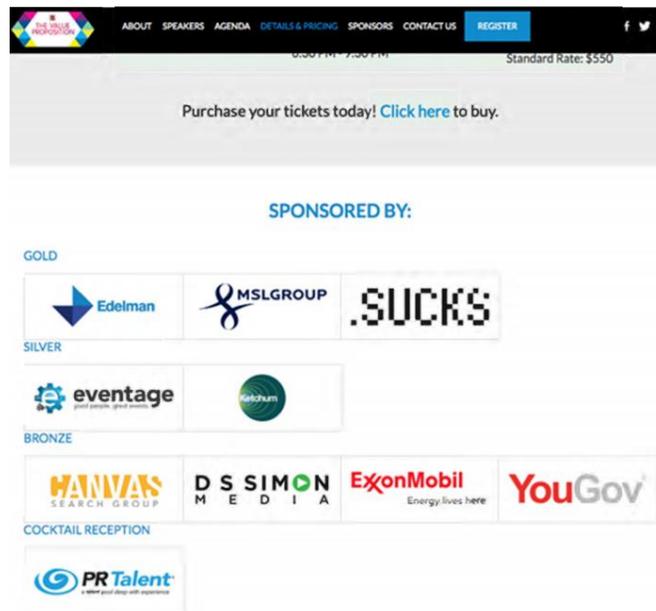
The Examining Attorney acknowledges the “retro pixelated font” that was used on “early CRT computer screens,” but asserts that the proposed mark “is not analogous to any of the marks in the cases cited in the applicant’s brief,” pointing out that “[a]ll of the characters in the applicant’s mark are the same height and width

⁴⁹ 4 TTABVUE 7.

⁵⁰ *Id.* at 5.

and are merely displayed in a font style that was once mandated by the technological limitations of computer screens.”⁵¹

As shown in the excerpts from Applicant’s website, supra, Applicant uses the mark **.SUCKS** at the top left-hand corner of the site in a manner that normally would suggest a trademark and as part of a “pixelated” theme on its webpage.⁵² The mark is also used alongside other trademarks in identifying “sponsors” for a “2016 PR Week Conference ‘The Value Proposition’” as well as on a banner above its booth at the conference:⁵³



⁵¹ *Id.* at 21

⁵² 4 TTABVUE 25.

⁵³ *Id.* at 31-32.



Although this type of evidence helps show Applicant’s intention to present the mark **.SUCKS** in manners that are customary for service marks, this does not mean that consumers will perceive it as such. In this case, we find Applicant’s efforts in this regard are undercut by the very nature of its domain registry operator services for the .SUCKS gTLD used in domain names. In other words, the evidence showing that consumers will perceive .SUCKS as merely a gTLD outweighs Applicant’s attempts to depict it as a source identifier. With respect to the pixelated design, or any “retro” suggestion, of Applicant’s mark, it does not create a sufficiently distinct commercial impression separate from the non-source-identifying element, .SUCKS. While the pixelated design may be antiquated since it was once “mandated by technological limitations,” given the ubiquity of the design in the “early days” of computing, consumers would view pixelated lettering as ordinary. We further note

that Applicant has not claimed that its mark has acquired distinctiveness under Section 2(f).

C. Conclusion

Applicant's mark **.SUCKS**, in its entirety, fails to function as a trademark for the recited services. Specifically, the stylized lettering or design element in the mark does not create a separate commercial impression and is not sufficiently distinctive to "carry" the overall mark into registrability.

Decision: The refusal to register Applicant's mark, **.SUCKS** (subject of Application '941) based on its failure to function as a mark is affirmed.

The refusal to register Applicant's mark **.SUCKS** (subject of Application '215) based on its failure to function as a mark is also affirmed.